

DOCKET NO: 199861US2S



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
YUTAKA TAKEUCHI ET AL. : GROUP: 2882
SERIAL NO: 09/716,400 : EXAMINER: GEMMELL, E.
FILED: NOVEMBER 21, 2000 :
FOR: SHADOW MASK, CATHODE RAY TUBE, METHOD AND APPARATUS FOR
MANUFACTURING SHADOW MASK ✓

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Restriction Requirement dated January 17, 2003, Applicants provisionally elect with traverse Group I, Claims 1-8, directed to shadow mask.

First, Applicants respectfully traverse this Restriction Requirement because the inventions subject to the restriction requirement have not been shown to be distinct in the manner required by M.P.E.P. §806.05(e). This portion of the manual indicates that for restrictions based on a process and apparatus for its practice, the Patent Office must demonstrate either

“(A) that process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) the apparatus *as claimed* can be practiced by another materially different process. (M.P.E.P. §806.05(e))...

The burden is on the examiner to provide reasonable examples that recite material differences.”

The outstanding Official Action finds that inventions II and III are distinct because

“[i]n this case the skirt portion could be clamped other than by using a welding head.”

However, the outstanding Official Action fails to state other differences by which it can be evaluated whether in fact the alternative method is “materially different”. Given this similarity

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in the method and apparatus claims, and the limited rationale provided in the official Action, Applicants respectfully submit that the PTO clearly has not carried forward its burden of proof to establish distinctness as required by §806.05(e).

Applicants also traverse this Restriction Requirement for the reason that the inventions subject to the restriction requirement have not been shown to be distinct in the manner required by M.P.E.P. §806.05(f). This portion of the manual indicates, the Patent Office must demonstrate either (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or (2) that the product as claimed can be made by another and materially different process.

Page 2 of the Restriction Requirement indicates that inventions I and II are distinct because "[i]n the instant case, a mask can be made without a concave portion."

Since the Restriction Requirement simply mentions a product that may be made by the claimed process, it cannot be said to have met the requirement of MPEP §806.05(f) as to showing a "materially different process" for making the product.

Finally, MPEP § 803 states:

MPEP § 803

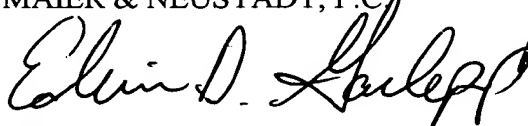
... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

However, the outstanding Restriction Requirement has not established that an undue burden would exist if the Restriction Requirement was not issued and all the claims were examined together. Moreover, the claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants respectfully also traverse the outstanding Restriction requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-17 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

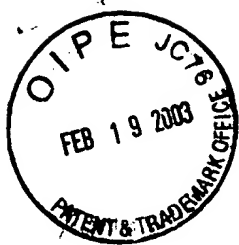


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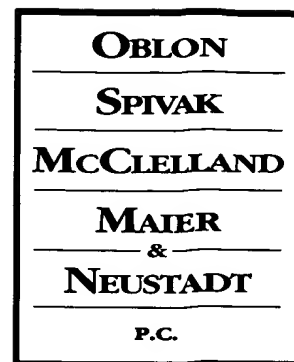
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RE: U.S. Application
Serial No: 09/716,400
Filed: November 21, 2000
Inventor: Yutaka TAKEUCHI et al.
For: Shadow Mask, Cathode Ray
Tube, Method and Apparatus for . . .

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT

Our check in the amount of \$--0-- is attached covering any required fees. In the event that any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is attached.

Respectfully submitted,



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